

REMARKS/ARGUMENTS

The office action of June 24, 2005, has been carefully reviewed and these remarks are responsive thereto. Claims 1, 16, and 28 have been amended, no claims have been canceled, and new claims 29-30 have been added. Claims 1-30 thus remain pending in this application. Reconsideration and allowance of the instant application are respectfully requested.

Allowable Subject Matter

The Office Action indicates that claims 23-25 stand objected to, but would be allowable if rewritten in independent form. Newly added claim 29 includes the recitations of claim 23 rewritten in independent form, including any intervening base claims. Newly added claim 30 is similar to pending claim 28, with added allowable features similar to dependent claim 23. Applicants therefore submit that claims 29 and 30 are now in allowable form.

Rejections Under 35 U.S.C. § 102

Claims 1-14, 16-21, 26, and 28 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Chow (U.S. Pat. No. 6,574,470). Applicants respectfully traverse this rejection for at least the following reasons.

In order to reject a claim as anticipated under 35 U.S.C. § 102, a single prior art reference must teach every aspect of the claimed invention. MPEP § 706.02. The present invention as claimed in claim 1 is directed to a method in a communication system which includes the step of maintaining a data channel in a "ready" state. This phrase is discussed in the final paragraph of page 4 of the application as filed as meaning that the channel is in such a state that it may transmit or receive data. Page 8, line 21 – page 10, line 10 explains a purpose of the invention as being to improve the manner in which the length of time for which a channel is maintained in the ready state is optimized. Various reasons why optimization is desirable are discussed. One reason is to prevent the ready state from changing until transmission of a data stream is complete.

By contrast, Chow is concerned with enabling a telephone user to move location whilst maintaining use of the telephone system. This is explained in the abstract of Chow. The object is further explained in the background section of Chow (columns 1-2) to be to provide a wireless

system which has both wireless features and features which are traditionally only provided in a landline system. Columns 3-10 discuss various phone system features which are implemented in the wireless centrex system of Chow, such as call hold, call forwarding, call waiting and conference calls. These are commonly-known telephone system features and their implementation in the Chow system is described in detail with respect to the figures.

The part of Chow referred to by the Office Action is columns 68-69 and figures 32 and 33, which are part of the description of the "Call Forwarding" section (see column 66, line 52). They are under the sub-heading "B. Programmable Ring Call Forwarding" (see column 67, line 45). It can thus be immediately understood that this part of Chow refers to a known telephone system feature (i.e., forwarding a call to another number or voicemail when the call is unanswered) and is thus not at all concerned with maintaining a data channel in a ready state, as recited in claim 1. Chow gives no mention of a data channel as recited throughout claim 1, but rather Chow is here concerned with a voice channel.

Although Chow does discuss the phone being allowed to ring without being answered until a time-out period has expired, there is no disclosure of "maintaining the data channel in a ready state" as recited in the claim, at least because the "ready state" is not disclosed or described in Chow. Chow also lacks a disclosure of "initiating transmission of data on the data channel" because the only channel disclosed in Chow is a voice connection.

Crucially, even if the voice connection of Chow were considered to be a data channel in the ready state, Chow still does not disclose that the state of the data channel is prevented from changing the ready state based on the timer, "until a predefined event" has occurred, as recited in claim 1. As mentioned above, the Office Action does not indicate where in Chow the alleged "predefined event" is disclosed. The only events which take place in Chow are answering of the call or non-answering of the call. There is no disclosure of any "prevention" of changing the state of a data channel. If the call is answered by the mobile user, it is routed to the mobile station. Although the call then proceeds independently of the time-out function, there is no "predefined event" which has anything to do with preventing changing of the state of a data channel until such an event occurs. If on the other hand the call is not answered within the time-out period, the call is

forwarded. Thus, the state of the voice channel has been changed and no predefined event has prevented a change.

In other words, should, for example, a voice call be in progress in the system of Chow, there is no “predefined event” which prevents the state of that voice connection being changed before the call has finished, i.e., “until a predefined event.”

Therefore, claim 1 is not anticipated by Chow because several features of claim 1 are not disclosed or described by Chow. Claim 1 is also novel over Chow because it solves the problem of optimizing the time for which a data channel is maintained in a ready state, whereas Chow neither addresses nor solves this problem.

The Office Action refers to the same part of Chow to reject independent claims 16 and 28. Since these claims contain similar limitations to claim 1, the above arguments apply equally to these claims. Claims 2-14, 17-21, and 26 are allowable for at least the same reasons as their respective base claims.

Rejections Under 35 U.S.C. § 103

Claims 15 and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Chow in view of allegedly admitted prior art.

Claim 22 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Chow in view of Labonte (U.S. Pat. No. 5,991,286).

Applicants respectfully submit that claims 15, 22, and 27 are allowable for at least the same reasons as their respective base claims, because the combination of references does not cure the above-described deficiencies of Chow. In addition, while the background section of the application refers to TETRA, the background does not provide a motivation or suggestion to combine Chow with the use of TETRA. A mere reference to a technology does not provide a motivation or suggestion to use it, and the Office Action has thus not established a *prima facie* case of obviousness with respect to claims 15 and 27.

Furthermore, with respect to claim 22, the Office Action provides no motivation or suggestion to combine Chow with Labonte, except to state that it would have been obvious “to allow the network to be able to control the timer and not the data transmission.” However, this is

not a motivation or suggestion to combine, but is instead the end-result of the alleged combination. The end-result cannot make the combination obvious, with some motivation or suggestion to combine the references in the first place. That is, if the end-result can provide the necessary motivation to combine references, then any two references could be combined merely by demonstrating the end-result of their combination. This is improper hindsight. The Office Action has thus also failed to establish a *prima facie* case of obviousness with respect to claim 22.

CONCLUSION


All rejections having been addressed, applicant respectfully submits that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same. However, if for any reason the Examiner believes the application is not in condition for allowance or there are any questions, the examiner is requested to contact the undersigned at (202) 824-3153.

Respectfully submitted,

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